

REMARKS

This is in full and timely response to the Restriction Requirement made in the Office Action mailed on December 22, 2005. Reexamination in light of the following remarks is respectfully requested.

Claims 1-10 are pending in this application, with claims 1 and 7 being independent.

No new matter has been added.

Restriction Requirement

The Restriction Requirement of December 22, 2005 asserts an existence of the following patentably distinct inventions:

- An alleged Group I, claims 1-6: drawn to a pneumatic tire comprising an object fixed to a tread inner surface by a ring-shaped jig, the object being changed in sectional area in accordance with a position in a tire circumference, allegedly classified in class 152, subclass 450.
- An alleged Group II, claims 7-10: drawn to a tire cavity resonance suppression device, comprising a ring-shaped jig and an object changed in sectional area in accordance with a position in a tire circumference, allegedly classified in class 181, subclass 208.

Election

The Applicant, through its representatives and attorneys, hereby provisionally elects, with traverse, the invention of the alleged Group I invention having claims 1-6.

Traversal

For the reasons provided hereinbelow, the Restriction Requirement made within the Office Action mailed on July December 22, 2005 is respectfully **traversed**.

The Restriction Requirement contends that the alleged Group I and the alleged Group II are patentably distinct because they are related as combination and subcombination.

In response to this contention, M.P.E.P. §806.05(c) provides that the inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

M.P.E.P. §806.05(c) further provides that when the above-identified factors cannot be shown, such inventions **are not distinct**.

The Restriction Requirement contends that the combination as claimed does not require the particulars of the subcombination as claimed because the particulars of the combination (pneumatic tire structure, device attached to tread inner surface rather than another location on the tire inner surface or a location on the rim) show that the particulars of the subcombination are not the sole basis for patentability of the combination.

In response to this contention, the Restriction Requirement has failed to show that a combination as claimed (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness).

Specifically, the Restriction Requirement has failed to identify with particularity the alleged combination and subcombination for each of the alleged Groups. In this regard, the Restriction Requirement is incomplete. M.P.E.P. §707.07.

Moreover, note upon review of the independent claims that:

Claim 1 is drawn to a pneumatic tire, comprising an object fixed to a tread inner surface by *a ring-shaped jig made of an elastic body, the object being changed in sectional area in accordance with a position in a tire circumferential direction.*

Claim 7 is drawn to a tire cavity resonance suppression device, comprising: *an object changed in sectional area in accordance with a position in a tire circumferential direction; and a ring-shaped jig made of an elastic body* for locking the object to a tread inner surface of the tire.

In this regard, claim 1 provides for the object being changed in sectional area in accordance with a position in a tire circumferential direction, while claim 7 provides for an object changed in sectional area in accordance with a position in a tire circumferential direction.

Both claims 1 and 7 include a ring-shaped jig made of an elastic body.

While claim 1 provides for an object fixed to a tread inner surface, claim 7 provides for locking the object to a tread inner surface of the tire.

Yet, the Restriction Requirement has failed to show that the specific characteristics found within claim 1 are not required by claim 7. Thus, the Restriction Requirement has failed to show that the alleged Group I invention and the alleged Group II invention are distinct.

Therefore, a requirement for restriction must not be made or maintained, even if the subcombination has separate utility. M.P.E.P. §806.05(c)(I).

The Restriction Requirement contends that the alleged Group I is classified in class 152, subclass 450, and that the alleged Group II is classified in class 181, subclass 208.

In response, U.S. Patent and Trademark practice and procedures dictate that not only must the art be searched within which the invention claimed is classifiable, but also all analogous arts regardless of where classified. M.P.E.P. § 904.01(c).

In addition, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. M.P.E.P. §803.



The Restriction Requirement made within the Restriction Requirement of December 22, 2005 is believed to be improper, at least for the reasons provided hereinabove.

Accordingly, withdrawal of this restriction requirement and examination of all pending claims is respectfully requested. An early Action on the merits of this application is additionally respectfully requested.

Applicant believes no fee is due with this response. If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

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Respectfully submitted,

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